



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/830,071	04/23/2004	Kishore M. Gadde		7687

20995	7590	07/18/2007
KNOBBE MARTENS OLSON & BEAR LLP		
2040 MAIN STREET		
FOURTEENTH FLOOR		
IRVINE, CA 92614		

EXAMINER	
HENLEY III, RAYMOND J	

ART UNIT	PAPER NUMBER
1614	

NOTIFICATION DATE	DELIVERY MODE
07/18/2007	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

jcartee@kmob.com  
eOAPilot@kmob.com

## Office Action Summary

Application No.

10/830,071

Applicant(s)

GADDE ET AL.

Examiner

Raymond J. Henley III

Art Unit

1614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 April 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 18-26 and 35-52 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 18-26 and 35-52 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**CLAIMS 18-26 AND 35-52 ARE PRESENTED FOR EXAMINATION**

Applicants' amendment, (with attachments), and Information Disclosure Statement filed April 25, 2007 have been received and entered into the application. Accordingly, claims 18, 25, 35 and 42 have been amended; claims 27-34 have been canceled; and claims 44-52 have been added. Also, as reflected by the attached, completed copies of form PTO/SB/08, (3 sheets), the cited references have been considered.

In view of Applicants' remarks, the teachings of Exhibit 1, (FDA Approved Labeling Text for zonisamide), and amendments, the rejections under 35 U.S.C. § 112, first and second paragraph and under 35 U.S.C. § 103 over Ayala, (*Epilepsia*, Vol. 41, Suppl. 7 2000), and over Coffin et al., (U.S. Patent Application Publication No. 2001/0025038), either taken alone or in combination with Shank, (U.S. Patent No. 6,071,537) and Anderson et al., (U.S. Patent No. 6,437,147), as maintained in the previous Office action dated January 26, 2007, have been overcome and are therefor here withdrawn.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

***Claim Rejection - 35 USC § 102***

Claims 18-26 and 35-52 are rejected under 35 U.S.C. 102(e) as being anticipated by Jennings, (U.S. Patent Application Publication No. 2004/0029941), already of record, for the reasons of record as maintained in the previous Office action dated January 26, 2007, as applied to claims 18-43, which reasons are here incorporated by reference.

Art Unit: 1614

Applicants' remarks have been carefully considered, but fail to persuade the Examiner of error in maintaining this rejection.

In particular, Applicants' offer to swear behind Jennings cannot take the place of a proper showing of priority, (MPEP § 2304.02(c), 37 CFR 41.202 and 37 CFR 1.130-1.132).

Accordingly, based on the content of the present record, Jennings remains a proper reference under 35 U.S.C. § 102(e).

### ***Request for Interference***

Applicants have reminded the Office that a request for interference between the present application and Jennings has been made of record in a submission filed by Applicants on April 23, 2004.

Consideration of a potential interference is premature because examination of neither this application nor the Jennings application has been completed as required by 37 CFR 41.102(a), (see MPEP § 2303).

### ***Double Patenting***

#### **Provisional**

*I* Claims 18-26 and 35-52 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 18-34 of copending Application No. 11/058,981, for the reasons of record as maintained in the previous Office action dated January 26, 2007, as applied to claims 18-43, which reasons are here incorporated by reference.

This is a provisional obviousness-type double patenting rejection.

Art Unit: 1614

**II** Claims 18-26 and 35-52 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 18-34 of copending Application No. 11/059,027, for the reasons of record as maintained in the previous Office action dated January 26, 2007, as applied to claims 18-43, which reasons are here incorporated by reference.

This is a provisional obviousness-type double patenting rejection.

**III** Claims 18-26 and 35-52 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 18-34 of copending Application No. 11/034,316, for the reasons of record as maintained in the previous Office action dated January 26, 2007, as applied to claims 18-43, which reasons are here incorporated by reference.

This is a provisional obviousness-type double patenting rejection.

**Non-Provisional**

Claims 18-26 and 35-52 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-11 of U.S. Patent No. 7,109,198, already of record, for the reasons of record as maintained in the previous Office action dated January 26, 2007, as applied to claims 18-43, which reasons are here incorporated by reference.

***Applicants' Remarks***

Applicants' request to hold the above double-patenting rejections in abeyance is noted. Insofar as persuasive arguments or properly executed terminal disclaimers have not been filed, the rejections are deemed to remain proper.

None of the claims are currently in condition for allowance.

**THIS ACTION IS MADE FINAL.** Applicants are reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

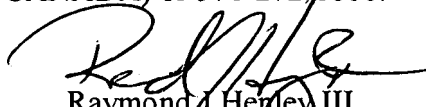
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raymond J. Henley III whose telephone number is 571-272-0575. The examiner can normally be reached on M-F, 8:30 am to 4:00 pm Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin H. Marschel can be reached on 571-272-0718. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would

Art Unit: 1614

like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Raymond J. Henley III  
Primary Examiner  
Art Unit 1614

July 6, 2007